

REMARKS

Claims 1-29 are pending in the application. Claims 1, 3, 4, 6, 7, 9, 10, 12, 16, 18 and 20 have been amended. Claims 21-29 are newly added. Reconsideration of this application is respectfully requested.

The Office Action rejects claims 1, 2, 7, 8 and 16-20 under 35 U.S.C 103(a) as unpatentable over U.S. Patent No. 5,950,128 to Ghisler, hereafter Ghisler, in view of U.S Patent No. 5,737,707 to Gaulke et al., hereafter Gaulke.

Ghisler uses a paging system that alerts a cell phone user to turn on the cell phone. Ghisler has a local service provider 105 that has control over communications with cell phone 107. The user of cell phone has a pager 108. When a subscriber A calls cell phone 107 and cell phone 107 does not answer, the call is routed to a wide area paging system that sends a paging message to pager 108 to alert the user of cell phone 107 to answer the call.

In contrast, the method of claim 1, the computer of claim 7 and the memory medium of claim 16 identify a location of a passive device by finding the local service provider that has control over communications of an active device that is associated with the passive device. When the location is so identified, the local service provider sends a data message to the passive device.

Claims 1, 7 and 16 have each been amended to recite that a location of the passive device is identified by finding the local service provider that has control over communications of an active device that is associated with the passive device.

Ghisler uses two providers, local service provider 105 and wide area paging system 106. In contrast, claim 1 recites only one local service provider

that has control over the communications of the active device associated with the passive device and that also sends the data message to the passive device. Ghisler's local service provider has control over the communications of cell phone 107, but has no capability to send data messages to pager 108. Ghisler teaches to use wide area paging system to send messages to pager 108. Accordingly, Ghisler lacks a local service provider that both has control over the communications of an active device and sends data communications to an associated passive device.

The Office Action concession that Ghisler fails to teach identifying a location of a system for retransmit to a passive device is moot due to the amendment to claims 1, 7 and 16 as these claims identify a location of a passive device by finding a local service provider that has control over the communications of the associated active device. Moreover, the concession is in error because claims 1, 7 and 16, in original or in amended form, do not recite a "retransmit" to a passive device.

It is noted that Gaulke teaches the same system as Ghisler, except that the pager 122 and cell phone 121 have a connection that allows pager 122 to turn on cell phone 121 when an alert is sent to pager 122 by paging system 106. Like Ghisler, Gaulke teaches a separate cellular system 103 that has control over the communications of cell phone 121.

For the reasons set forth above, it is submitted that the rejection of claims 1, 2, 7, 8 and 16-20 under 35 U.S.C 103(a) as unpatentable over Ghisler in view of Gaulke is inapplicable to these claims as amended and should be withdrawn.

The Office Action rejects claims 3-6 and 9-12 under 35 U.S.C 103(a) as unpatentable over Ghisler and Gaulke in view of U.S Patent No. 5,742,905 to Pepe et al., hereafter Pepe.

Pepe is cited as teaching a list of passive devices. Pepe does not disclose the identifying step or means of independent claims 1 and 7, from which claims 3-6 and 9-12 respectively depend as discussed above in the discussion concerning the rejection of claims 1 and 7. Accordingly, it is submitted that this rejection is obviated by the amendment to claims 1 and 7 and should be withdrawn.

The Office Action concludes that it would be obvious to provide the teaching of Pepe into the system of Ghisler in order to enhance system performance of increasing the answering probability of calls to mobile radio terminals. This conclusion is erroneous because none of the devices listed in Pepe would enhance the call answering probability of calls.

The Office Action suggestion to use the passive devices of Pepe in combination with Ghisler is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 3-6 and 9-12 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claims 13-15 under 35 U.S.C 103(a) as unpatentable over Ghisler in view of U.S Patent No. 6,100,806 to Gaukel, hereafter Gaukel.

The Office Action acknowledges that Ghisler does not disclose a transmitter capable of transmitting an identity message only a short distance. The Office Action cites Gaukel as teaching a passive device that is capable of transmitting an identity message only a short distance to an active device. The Office Action concludes that it would have been obvious to provide the teaching of Gaukel into the system of Ghisler to send the messages from the passive device to active device.

The Office Action cites for support Gaukel's Figures 3 and 7, but does not identify what devices in these Figures are regarded as passive or active. It is noted that cellular bag 30 has a cellular communication capability and, therefore, is regarded as an active device. On the other hand, wristband 20 has no cellular capability and, therefore, is assumed to be passive. Wristband 20 monitors various parameters of the wearer and provides the parameter data via a cable to cellular bag 30. Figure 7 merely discloses the specific monitoring devices of wristband 20. Wristband 20 does not have a transmitter and, contrary to the Examiner's position, does not appear to send an identity message to cellular bag 30. Accordingly, Gaukel fails to teach a transmitter capable of transmitting an identity message only a short distance.

The Office Action suggestion to use any teaching of Gaukel in combination with Ghisler is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ

2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F.

2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

In this case, Gaukel's device is a system that tracks individuals who are under house arrest or are being monitored for medical conditions. On the other hand, Ghisler's device is for enhancing the answering probability of calls placed to a mobile telephone. There is no reason for one of ordinary skill in the art to use the monitoring teachings of Gaukel in Ghisler's mobile telephone system.

For the reasons set forth above, it is submitted that the rejection of claims 13-15 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claims 1, 2, 7, 8 and 16-20 under 35 U.S.C 103(a) as unpatentable over Ghisler in view of U.S Patent No. 5,797,097 to Roach, Jr. et al., hereafter Roach.

As noted above in the discussion concerning the rejection of independent claims 1, 7 and 16 as obvious over Ghisler in view of Gaulke, Ghisler does not teach a single local service provider that both has control over communications with an active device associated with an active device and sends data messages to the passive device.

Roach teaches a combination paging device 70 and cellular communications device 72 that uses the control signaling channel of cellular communications device 72 to provide its location via a cell 12 to a segmented paging system 31. Segmented paging system 31 uses the location of the paging device to select an antenna 34 having cognizance over such location to send paging messages to paging device 72. In contrast, claims 1, 7 and 16 recite that the same local service provider that has cognizance over communications of the active device also sends data messages to the passive device. Roach's paging device 70 can only receive data or paging messages via antenna 82 from a

selected antenna 34 and not from the cell 12. For this reason, it is submitted that the rejection of claims 1, 2, 7, 8 and 16-20 under 35 U.S.C 103(a) as unpatentable over Ghisler in view of Roach is inapplicable.

The Office Action provides no motivation for one skilled in the art to combine Ghisler's alerting system with Roach's pager locating system. The suggested combination of Ghisler and Roach is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 1, 2, 7, 8 and 16-20 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claims 3-6 and 9-12 under 35 U.S.C 103(a) as unpatentable over Ghisler and Roach in view of Pepe.

Pepe is cited as teaching a list of passive devices. Pepe does not disclose the identifying step or means of independent claims 1 and 7, from which claims 3-6 and 9-12 respectively depend as discussed above in the discussion concerning the rejection of claims 1 and 7. Accordingly, it is submitted that this rejection is obviated by the amendment to claims 1 and 7 and should be withdrawn.

The Office Action concludes that it would be obvious to provide the teaching of Pepe into the system of Ghisler in order to enhance system performance of increasing the answering probability of calls to mobile radio terminals. This conclusion is erroneous because none of the devices listed in Pepe would enhance the call answering probability of calls.

The Office Action suggestion to use the passive devices of Pepe in combination with Ghisler is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerasonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 3-6 and 9-12 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

Newly presented claims 21-28 recite a passive device and method comprising a low power transmitter and a receiver. The low power transmitter has a transmission range that includes a nearby active device, but not a local service provider. The transmitter transmits to the active device at least one signal that identifies the passive device and its location of close proximity to the active device for relay to a global registry. The receiver is capable of receiving data messages from the local service provider after the identity and location of the passive device have been entered in the global registry. None of the cited references teach this passive device and method. Accordingly, it is submitted that claims 21-28 distinguish from the cited art and are, therefore, allowable.

Newly presented claim 29 recites a repetition of steps (a) and (b) for an additional data message such that the local service provider identified by the repeated steps is one that currently has control over the communications of the active device so as to permit the passive device to be movable to new locations and still be able to receive the additional data message. None of the cited references teach this feature. Accordingly, it is submitted that claim 29 distinguishes from the cited art and is, therefore, allowable.

It is respectfully requested for the reasons set forth above that the rejections under 35 U.S.C. 103(a) be withdrawn, that claims 21-28 be allowed and that this application be passed to issue.

Respectfully Submitted,

Date: 7-1-03



Paul D. Greeley
Reg. No. 31,019
Attorney for Applicants
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
One Landmark Square, 10th Floor
Stamford, CT 06901-2682
(203) 327-4500